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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,467	12/27/2001	Hidehei Kageyama	NO. 49	7790

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EXAMINER

PRUNNER, KATHLEEN J

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/026,467

Applicant(s)

KAGEVARNA ET AL.

Examiner

Kathleen J. Prunner

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4,5,11-19 and 21-23 is/are allowed.
- 6) ☒ Claim(s) 6,7,10 and 20 is/are rejected.
- 7) ☒ Claim(s) 8,9 and 24-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The following informalities in the claims are noted: (A) in claim 6, on line 2, a semi-colon should be inserted after "purpose"; (B) in claim 7, on line 2, "a" should read --the--; (C) in claim 9, on line 3, "a" (second occurrence) should be changed to read --said--; (D) in claim 9, on line 4, "a holder" should read --said holders--; (E) in claim 9, on line 5, --said-- should be inserted after "and"; (F) in claim 9, on line 6, "folder" should read --holders--; (G) in claim 24, on line 1, "a" should read --the supported--; (H) in claim 24, on line 2, "holder" should be changed to read --holders--; (I) in claim 25, on lines 3 and 4, "holder" should be changed to read --holders--; and (J) in claim 26, on line 1, "part" should read --section-- and "said holder" should read --each holder--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 6 and 10 are rejected under 35 U.S.C. 102(a) as being anticipated by Ham. Ham discloses a composite holding device having all the claimed features including a holder body (constituted by section 30) for holding a first medium (constituted by writing point 45) to serve a prescribed purpose, an external sleeve 27 having a fore end receiving a portion of the holder body 30, and a cap (constituted by writing point 20) received by a rear end of the external sleeve 27, wherein the cap 20 comprises a casing for accommodating a plurality of holders 80, 82, each holder holding a second medium to serve a purpose either different from or similar to that of the first medium 40, a supporting section for supporting the holders to be movable in an axial

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direction in the casing (note Fig. 6), a feed mechanism 84, provided in the casing, for selectively advancing one of the plurality of holders (note lines 45-47 in col. 3), and a manipulating mechanism (constituted by the selector, note lines 47-49 in col. 3) for operating the feed mechanism being adapted to project a tip of one of the plurality of holders 80, 82 out of a fore end opening at a tip of the casing and make usable the tip of one of the plurality of holders 80, 82. With respect to claim 10, Ham also discloses that the media are selected from a group of writing related media that includes ink (note lines 38-44 in col. 3 and lines 2-9 in col. 4) and a data inputting media that includes a stylus (note lines 1-2 in col. 4).

4. Claims 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Sansevero. Sansevero discloses a composite holding device having all the claimed features including a casing (constituted by barrel 10) for accommodating a plurality of holders 55, 55x for holding media, a supporting section (constituted by followers 40, 40x) for supporting the holders 55, 55x to be movable (note Figs. 7 and 8), means for selectively advancing one of the plurality of holders 55, 55x, and means for operating the advancing means (note from line 53 in col. 3 to line 4 in col. 4) which is adapted to project a tip of one of the plurality of holders 55, 55x out a fore end opening at a tip of the casing and make usable the tip of the one of the plurality of holders 55, 55x (note Figs. 7 and 8) wherein the supporting section is adapted to support a section of each holder 55, 55x such that the supported section is adapted to be rotatably supported in relation to the supporting section (note lines 56-61 in col. 1, lines 39-52 in col. 3 and Fig. 10).

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ham in view of Sansevero. Although Ham fails to disclose the specific structure for extending and retracting the holders 80 and 82, attention is directed to Sansevero who discloses another writing or marking instrument having a plurality of holders 55, 55x and having a supporting section adapted to support the supported section of each holder such that the supported section is adapted to be rotatably supported in relation to the supporting section (note lines 56-61 in col. 1, lines 39-52 in col. 3 and Fig. 10) in order to provide an instrument that is simple to fabricate and to assemble is reliable and provides a long useful life with a smooth positive action (note lines 30-36 in col. 1). It would have been obvious to one of ordinary skill in the writing or marking instrument art, at the time the invention was made, to have the supported section of Ham to be rotatably supported in relation to the supporting section in view of the teachings of Sansevero in order to provide an instrument that is simple to fabricate and to assemble, is reliable and provides a long useful life with a smooth positive operating action.

#### ***Allowable Subject Matter***

7. Claims 1, 4, 5, 21-23 and 11-19 are allowed.
8. Claims 8, 9 and 24-27 are objected to as being dependent upon a rejected base claim, but would be allowable if claims 8 and 24 are rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

9. Applicant's arguments filed August 4, 2004 have been fully considered but they are not deemed persuasive.
10. Applicant's arguments with respect to claims 6 and 20 have been considered but are moot in view of the new ground(s) of rejection.

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*Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044.

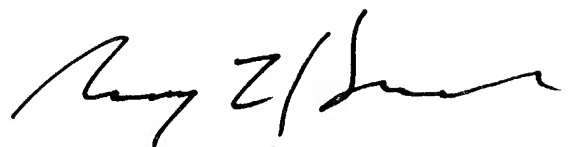
12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen J. Prunner

September 21, 2004



GREGORY L. HUSON  
SUPERVISORY PATENT EXAMINER  
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